

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: CHEN, HORN
Application No.: 09/716757
Filed: November 20, 2000
For: Hybrid Sleeve Material and Structure
Examiner: Urmi Chattopadhyay
Group Art Unit: 3738
Firm Docket No.: S63.2B-9494-US01

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Respectfully submitted,
VIDAS, ARRETT & STEINKRAUS

Date: March 15, 2004

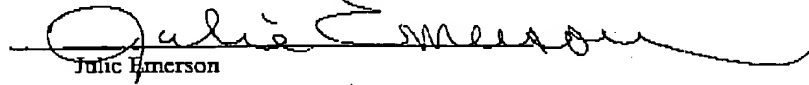
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Docket No.: S63.2B-9494-US01

REPLY BRIEF

The Examiner's Answer was mailed January 13, 2004 and this reply brief is being filed pursuant to 37 CFR 1.193(b)(1) with 2 months of the date of mailing of the Examiner's Answer.

The Examiner makes three points that Applicant will reply to. First, the Examiner maintains that claims 1, 11 and 12 do not require that the sleeve *consist* of a tubing, arguing that the claim term "composed" is open. Second, the Examiner discusses whether the ring of Willard is part of the sleeve. Third, the Examiner raises the issue that claim 1 now appears to be drawn to a non-elected subspecies, as construed by Applicant.

Applicant also offers a suggested amendment at the end of this reply, for the Examiner's consideration.

I. The claim term "composed" is closed

Claim 1, for example, requires "the inside surface being composed of a second material." Applicant has taken the position that this requires the entire inside surface of

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the sleeve to be made of the second material, rather than a portion. The Examiner indicates that the term "composed" is open, like "comprising".

Landis on Mechanics of Patent Claim Drafting, fifth Edition, §2:6 states that "composed of" is closed ended, like "consisting" or "consisting of". Pages 2-14 to 2-15. This is also consistent with the dictionary definition of "composed" which is "to make up the constituent parts of", see American Heritage Dictionary, Second College Edition. Here, applicant clearly indicates that the second material is the constitute which makes up the entire inside surface of the sleeve. Therefore, Applicant disagrees with the Examiner that "composed" is open, but rather the common meaning of the term and well respected claim drafting treatises agree that "composed" is a closed ended phrase, like "consisting".

II. Because "composed" is closed – the Ring of Willard Is Not Part of the Sleeve

Because the claim term "composed", used in claims 1 and 11 is closed and not open as the Examiner asserts, but rather a closed term, the Examiner's argument as to why the "ring" of Willard is part of the sleeve is now moot.

In fact, the "ring" of Willard is a totally separate element and not part of the sleeve, but is merely attached to the sleeve. Therefore, the fact that the ring could be made of metal, such as platinum is not relevant – because the ring is not part of the sleeve and therefore not part of the inside surface of the sleeve. Willard teaches nothing about the inside surface of the sleeve being harder than the outside surface. Is only by "forcing" the ring to be considered part of the sleeve that the Examiner is able to even argue anticipation based on Willard.

Furthermore, Willard teaches that the ring can be made of either metal or polyimide or polyethylene. As the Examiner concedes, polyimide and polyethylene may

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be harder or softer than the outside surface sleeve material. Because Willard teaches each ring material choice as equivalent, a "harder" inside surface material is not "necessarily present" in Willard and therefore Willard does not inherently anticipate claims 1, 11 or 12. Trintec Industries Inc. v. Top-U.S.A. Corp., 63 USPQ2d 1597 (Fed. Cir. 2002).

III. Applicant Elected Figure 2

It was only after reading the Examiner's Answer that applicant realized that there has been a fundamental misunderstanding between applicant and the Examiner as to the election of paper 4.

The Examiner identified Figures 1 and 2 as the a) and b) subspecies of the "arrangement of materials" subspecies of the invention. The Examiner never identified any structure which identified the difference between these two figures. The Examiner further identified **all** the independent claims 1, 11 and 12 as being generic.

In its election, applicant (not understanding what was in the Examiner's mind) made its election by identifying claims 1-6 and 9-12 – and never identified a particular figure, between Figure 1 or Figure 2. Applicant did intend to elect co-extruded rather than coated as to the second item of the subspecies identification, which is why claims 7-8 were not elected.

Applicant from the beginning always intended the claim 1 language "the inside surface being composed of a second material" to require the entire inside surface of the sleeve to be made of the second material, and always read claims 1, 11 and 12 to require the inside surface to be entirely made of the same material. Applicant may elect to pursue coverage of the other embodiment (partially composed of a second material) in a

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divisional application, but considered claims 1, 11 and 12 to relate to a single invention, and grouped the claims accordingly.

This can be seen in Applicant's response to the restriction requirement where applicant stated that:

"Applicant has amended claims 1, 11 and 12 to require that the inner surface be comprised [sic – claim language used was composed in claims 1 and 11] of the second material - which distinguishes over Willard where only the portion of the inside surface comprised of the ring material comprises the second material." (Emphasis added).

The amendments made to claims 1, 11 and 12 deleted "at least a portion of" which makes it clear that applicant intended the entire inside surface of the sleeve to be made of the same material.

Applicant now realizes that the Examiner misunderstood applicant's election to be to Figure 1, when all along Applicant never understood the difference in the Examiner's mind between Figure 1 and 2, and therefore elected claims 1-6 and 9-12 as a group – not understanding that it was reading claim 1 differently than the Examiner was.

Therefore, to the extent that Applicant elected a Figure when it identified its elected claims in response to the restriction requirement it intended to elect Figure 2, which is shown by the argument set forth above in its response to the restriction requirement.

It is only now that Applicant realizes the difference between the two figures to the Examiner was the length of the line drawn between the outside surface and inside surface of the sleeve. It is only now that Applicant sees the confusion and that applicant and Examiner were talking past each other, not understanding this confusion.

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To summarize – based on the Examiner's Answer Applicant realizes that it intended to elect Figure 2 and that it had elected Figure 2 all along – and not Figure 1 as the Examiner assumed. This was not evident because it is only now that applicant realizes what structure the Examiner understands to be patentably distinct between Figures 1 and 2.

IV. Suggested Amendment to Claims 1 and 11

In order to make the claim language explicitly closed, applicant also proposes amending claim 1, line 11 (as set forth in the claims appendix in the Appeal Brief) to delete --being composed of-- and substitute "consisting of" in its place. The same amendment would be made in claim 1, line 12. Finally, the same amendment would be made in claim 11, line 9.

Claim 12, line 6 could be amended to delete --having-- and insert "consisting of" in its place.

If this was acceptable to the Examiner, the proposed amendments could be made by Examiner's amendment, and are believed to moot the rejection as to claims 1-5 and 9-12.

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CONCLUSION

Based on the foregoing, applicant believes that the Examiner has misread and misapplied Willard. Therefore, the Board is respectfully requested to reverse the §102(e) rejection of claims 1-5 and 9-12.

Respectfully submitted,

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Date: March 15, 2004

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